

REMARKS

1. In response to the Office Action mailed February 20, 2007, Applicants respectfully requests reconsideration. Claims 1-32 were previously presented in the application. In the outstanding Office Action, claims 1-10 and 13-32 were rejected and claims 11 and 12 were objected to. By the foregoing Amendments, claims 24, 26, and 29 have been amended. No claims have been canceled or have been added. Thus, upon entry of this paper, claims 1-32 will be pending in this application. Of these thirty-two (32) claims, five (5) claims (claims 1, 22, 24, 31 and 32) are independent. Based on the above Amendments and following Remarks, Applicant respectfully requests that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

Allowable Subject Matter

2. Applicants note with appreciation the Examiner's indication that claims 11-12 would be allowable if rewritten in independent form including all imitations of the base claim and any intervening claims. Additionally, Applicants note with appreciation the Examiner's indication that claims 27-28 would be allowable if rewritten in independent form including all imitations of the base claim and any intervening claims and amended to overcome the rejections under 35 U.S.C. §101.

Claim Rejections under 35 U.S.C. §101

3. Independent claim 24 and dependent claims 25-30 have been rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Based upon the following Remarks, Applicants respectfully request reconsideration and withdrawal of these rejections.

4. In rejecting claims 24-30, the Examiner asserted that the claims do not appear to be constitute a tangible result because the outcome is allegedly not used in a disclosed practical application, nor made available in such a manner that it's usefulness in a disclosed practical application can be realized. (*See*, Office Action at 2.) The Examiner further asserted that a claim would provide a tangible result if the output was "conveyed to someone," displayed or stored by a user.

5. Without commenting on the propriety of this rejection, Applicants have amended

claim 24 to recite “transmitting at least one signal indicative of absence of said faults...,” to expedite prosecution of the present Application. As such, as amended, the output is conveyed to someone. As acknowledged by the Examiner, a claim provides a tangible result if the output is conveyed to someone. Applicants accordingly respectfully submit that amended claims 24-30 satisfy the requirements of 35 U.S.C. §101 and, therefore, request that the Examiner reconsider and withdraw the rejections to claims 24-30.

Claim Rejections under 35 U.S.C. §102 and §103

6. Independent claims 1, 22, 24, and 31-32 and dependent claims 2-9, 13, 15-17, 25-26 and 29-30 have been rejected under 35 U.S.C. § 102(e) as clearly anticipated by U.S. Patent No. 6,546,507 to Coyle, *et al.* (hereinafter, “Coyle”). Dependent claim 14 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Coyle in view of U.S. Patent No. 5,119,021 to Taraci, *et al.* (hereinafter, “Taraci”). Dependent claims 18-21 and 23 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Coyle in view of U.S. Publication No. 2003/0101020 A1 to Hawkins, *et al.* (hereinafter, “Hawkins”). Based upon the following Remarks, Applicants respectfully request reconsideration and withdrawal of these rejections.

7. Independent claim 1 recites “a margin testing system for margin testing one or more components of an electronic system, comprising:

a fault bypass module incorporated in said electronic system, said fault bypass module configured to intercept at least one signal indicative of one or more faults associated with one or more of said components during margin testing of said electronic system and mask the at least one signal indicative of one or more faults by generating at least one signal indicative of absence of the one or more faults.” (*See*, Claim 1 above.)

8. In rejecting claim 1, the Examiner asserted that Coyle discloses a fault bypass module as claimed. Applicants respectfully disagree for at least the following reasons.

9. Coyle is directed to a system for testing and tuning a bus connecting electronic devices. (*See*, Coyle at col. 6 lns. 37-39.) In rejecting independent claim 1, the Examiner relied on the first failure capture module 2506 of Coyle as allegedly disclosing a fault bypass module as recited by claim 1. Coyle discloses that this first failure capture module 2506 identifies first failure conditions and captures attendant error related operating information at the time of the first failure. (*See*, Coyle at col. 35 lns. 18-30.)

10. In the Office Action, the Examiner asserted that FIGs. 28C, 28D, and col. 39 line 32 – col. 40 line 12 of Coyle allegedly disclose the first failure capture mode 2506 generating at least one signal indicative of the absence of a fault. (*See*, Office Action at 4.) These Figures and portion of Coyle disclose a method for establishing a baseline value for a signal parameter in a bus system. (*See*, Coyle at col. 39 Ins. 42-44.) This method starts by testing whether the system operates correctly at a given initial value. (*See*, Coyle at col. 39 Ins. 44-47.) If so, the initial value is adjusted and the system tests the new value. (*See*, Coyle at col. 39 Ins. 49-52.) This process then repeats until a value is reached where the system fails. (*See*, Coyle at col. 39 Ins. 52-55.) The value is then reset to the initial value and the system is tested again. (*See*, Coyle at col. 39 Ins. 55-57.) If the system passes, the initial value is then adjusted in the opposite direction that it was initially adjusted. (*See*, Coyle at col. 39 Ins. 57-65.) The system is then retested at this new value and if the system passes the value is adjusted again until a system failure is detected. (*See*, Coyle at col. 39 Ins. 65 col. 40 ln. 1.) The system then determines the average of the highest value and lowest value for which the system passed. (*See*, Coyle at col. 40 Ins. 1-4.) The system is then tested at this average value, and if it passes the method is finished. (*See*, Coyle at col. 40 Ins. 4-7.) If it fails, then a system failure is determined. (*See*, Coyle at col. 40 Ins. 5-6.) As such, this portion of Coyle discloses a method for determining the highest value and the lowest value for which the system's performance is acceptable (*i.e.*, the system passes) and then determining an intermediate value for the system to use in operations.

11. In response to Applicants arguments, the Examiner asserted, in the present Office Action, that Coyle teaches "mask[ing] the at least one signal indicative of one or more faults (not pass the value) by generating at least one signal indicative of absence of the one or more faults (pass the value)." (*See*, Office Action at 10.) In support the Examiner relied on the above discussed FIGs. 28C, 28D and col. 39 line 42-col. 40 line 12 of Coyle. (*See*, Office Action at 10.) If the Examiner is asserting that passing or not passing as disclosed by Coyle means transmitting or conveying the value, Applicants disagree. Rather, as discussed above, the term "pass" is used in Coyle to refer to determining whether the system performance is acceptable or not. It is not used by Coyle to refer to conveying the value.

12. If the Examiner is asserting that "pass" means determining that the system's performance is acceptable, Applicants disagree with the Examiner's rejection for the following reasons. Determining whether the system fails to perform acceptably at a particular test value cannot constitute masking a signal. Rather, this disclosure simply

discloses that if the system does not perform acceptably at particular test value, the system is determined to fail at this test value. Moreover, when the system is determined to fail, Coyle does not disclose masking a fault signal. Rather, the relied on portion of Coyle simply discloses that this failure is simply reported and the system is reset and tested at a new value. Although the system of Coyle may pass at this new test value, this determination that the system passes at this test value does not mask the prior determination of a failure. Rather, it is simply a new determination of whether the system passes or fails, and not the masking of a fault signal. That is, in the system of Coyle, when the test value is applied that results in a determination that the system passes, the test value at which the system failed is no longer being applied and, accordingly, the fault signals no longer exist for the test value resulting in the failure. Thus, because the fault signals resulting in the prior determination of a failure no longer exist, they cannot be masked.

13. Thus, Coyle does not teach or suggest masking a signal by generating a signal indicative of the absence of faults. Instead, as noted above, Coyle simply determines whether the system performance is acceptable at a variety of test values and then setting the system to operate at an intermediate value where the system's performance was acceptable.

14. Applicants therefore respectfully submit that Coyle fails to teach or suggest "a fault bypass module configured to intercept at least one signal indicative of one or more faults ... and mask the at least one signal indicative of one or more faults by generating at least one signal indicative of absence of the one or more faults," as recited by claim 1. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 for at least this reason.

15. In addition, as discussed in Applicants' previous response, contrary to the Examiner's assertion, the method illustrated by FIGs. 28B and 28C of Coyle is not performed by the first failure capture module 2506 of FIG. 25. Rather, Coyle discloses that the method illustrated by FIGs. 28B and 28C is performed by FIG. 25 as a whole and that the first failure capture module 2506 merely identifies first failure conditions and captures attendant error related operating information at the time of the first failure. (*See*, Coyle at col. 35 lns. 18-30; *also see*, col. 37 lns. 61-64.) As such, Coyle does not teach that the first failure capture module 2506 performs all the steps illustrated in FIG. 28, but merely discloses that it identifies first failure conditions. The Examiner, however, did not address this argument by Applicants, but instead simply restated the Examiner's previous rejection.

16. Applicants respectfully remind the Examiner of MPEP §707.07(f), which provides “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” As such, Applicants respectfully submit that the Examiner’s continued reliance on this ground of rejection without addressing Applicants argument was improper. Applicants therefore maintain their argument and respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 for at least this additional reason.

17. Independent claim 22 recites, in part, “a fault bypass module ... configured to intercept at least one signal indicative of one or more faults ... and mask the at least one signal indicative of one or more faults by generating at least one signal indicative of absence of the one or more faults.” As such, Applicants respectfully assert that independent claim 22 is allowable for at least one or more similar reasons to those discussed above with reference to independent claim 1.

18. Independent claim 24 recites, in part, “transmitting at least one signal indicative of absence of said faults, thereby masking said intercepted signals.” As such, Applicants respectfully assert that independent claim 24 is allowable for at least one or more similar reasons to those discussed above with reference to independent claim 1.

19. Independent claim 31 recites, in part, “means for masking said intercepted at least one signal by generating at least one signal indicative of absence of said at least one fault.” As such, Applicants respectfully assert that independent claim 31 is allowable for at least one or more similar reasons to those discussed above with reference to independent claim

Dependent Claims

20. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicants respectfully request that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

21. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael G. Verga', is written over a horizontal line.

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